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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/271,584	03/18/1999	EDUARDO BLUMWALD	4001	4345

7590 06/21/2002

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EXAMINER

KUBELIK, ANNE R

ART UNIT PAPER NUMBER

1638

DATE MAILED: 06/21/2002 28

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Applicati n N . 09/271,584	Applicant(s) BLUMWALD ET AL.	
	Examiner Anne R. Kubelik	Art Unit 1638	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 June 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 03 June 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☒ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☒ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: 55.

Claim(s) rejected: 1-14, 17-32, 53 and 54.

Claim(s) withdrawn from consideration: 15-16, 33 and 48-49.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

Continuation of 2. NOTE:

New issues: 112, 2nd: Claim 56, "comprising" should be replaced with --wherein the nucleic acid comprises--.

New matter: The phrase "wherein said nucleic acid molecule is not the sequence of the gene A_TM021B04.4 or complementary to all of the sequence of the gene A_TM021B04.4" in claims 1, 2, 4, 7 and 53 is not supported by the specification or the claims as originally filed. Pg 21, lines 17-18 of the specification simply provides a comparison of SEQ ID NO:1 to A_TM021B04.4 and does not specifically exclude A_TM021B04.4 from the claimed nucleic acid.

Continuation of 5. does NOT place the application in condition for allowance because:

112, 1st, enablement: Specification does not teach making functional fragments of a plant Na⁺/H⁺ transporter, wherein the fragment has Na⁺/H⁺ transporter activity, as stated in the prior Office action.

112, 1st, written description: Specification fails to teach isolated nucleic acids encoding plant Na⁺/H⁺ transporter wherein the nucleic acid has 30% identity to SEQ ID NO:1 and fails to teach how to make those nucleic acids.

102b rejections: Each of Brant et al, Sieyaku, Hahnenberger et al, and Young et al all teach a nucleic acid that would encode a "fragment of a plant polypeptide having Na⁺/H⁺ transporter activity". At least one amino acid encoded by the nucleic acid of each of Brant et al, Sieyaku, Hahnenberger et al, and Young et al would be a fragment of a plant polypeptide. Note that in the claims as written, "having Na⁺/H⁺ transporter activity" modifies "polypeptide" not "fragment". Thus, the rejections over each of Brant et al, Sieyaku, Hahnenberger et al, and Young et al stand.

103: rejections thus also remain for reasons of record. In response to Applicant's argument based upon the age of the references, contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See In re Wright, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

Continuation of 10. Other:

Claim 12 is improperly multiply dependent for reciting "any of claims 1-4" twice, and thus not clearly referring to other claims in the alternative.

Claim 55 remains objected to for being dependent upon a rejected base claim, as stated in the office action of 3 December, 2001.

112, 2nd rejections indicated in the Office action of 3 December, 2001 would be overcome by these amendments

DAVID T. FOX
PRIMARY EXAMINER
GROUP 100-1638

